

REMARKS

The Office required restriction citing 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 1-20, drawn to apparatus for extracting a sample from strip of material, classified in class 73, subclass 864-41;
- II. Claim 21, drawn to a method of extracting a sample from a material strip, classified in class 73, subclass 864.41;
- III. Claim 22, drawn to a method for removing a material sample from a material strip and testing said material, classified in class 73, subclass 159.

The Office indicates that each of the inventions are distinct from each other and that the search for Group 1 (claims 10-20) would not reveal references for Groups 2 and 3 (claims 21 and 22 respectively).

THE OFFICE ACTION DOES NOT ESTABLISH A PRIMA FACIE CASE SUGGESTING RESTRICTION UNDER 35 U.S.C. § 121

The statutory basis for restriction is found in 35 U.S.C. § 121 and states in relevant part, "if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." (emphasis supplied). Thus, the statutory basis for a proper restriction requires a showing that the inventions are both independent and distinct. Moreover, restriction is a permissive practice, improper when an Examiner will not be seriously burdened in searching the inventions described in the restricted claims. (MPEP § 803).

THE CLAIMS ARE DEPENDENT

In the pending restriction requirement, the Office has made no effort to show that the inventions as claimed are independent as required under 35 U.S.C. § 121. Indeed, Applicant can find no evidence in the detailed action that dependency or independency of the claims was even considered. For example, the Action appears to analyze only the element of distinct inventions

as evidenced by the remarks in numbered paragraphs 3 and 4. No discussion of independency appears.

Had the statutory requirement been analyzed, the restriction requirement would not have issued because the claims, as filed, are dependent upon each other. The MPEP, in section 802.1 provides a useful definition of the term "independent". There, "independent" claims, properly the subject of a restriction requirement, are considered those where there is no disclosed relationship between the two or more subjects, that is, they are unconnected in design, operation, or effect (MPEP § 802.1, 808.01).

In the case at hand, the Office asserts that the apparatus (group 1, claims 1-20) can be used to practice another and materially different process than that of group 2 (claim 21). The office uses the example of where a sample can be removed at any position, not just an ejection position.

This does not withstand scrutiny. Initially, the recitation of an ejection position in claim 21 defines a position of the rotating cutting wheel. Similarly, the apparatus claims likewise envision a rotating cutting wheel including position limitations (See e.g. claim 1, 9, and 16). Secondly, applicant asserts that removal of the sample "at any position," as used in the Office's example, would necessarily be a removal or "ejection position" as claimed. Finally, the Office notes that both the apparatus and method claims are classified in the exact same class and sub-class. Thus, the claims of group 1 and group 2 are dependent – that is, they are connected in design, operation and/or effect. (MPEP § 802.1, 808.01).

The restriction requirement between group 1 and group 3 is similarly deficient. The Office states that the apparatus does not require that tests be performed while the sample is held between the strips to determine physical properties. Claim 22 calls for performing tests on the sample held between a strips of a transport medium. Indeed, the Office concedes the presence of similar claims in the apparatus group 1 (last sentence of numbered paragraph 3). The Office continues that the method of group 3 could be performed by a materially different apparatus. That however, is not the test for proper restriction. The proper test is whether the claims are independent and distinct. 35 U.S.C. § 121. Here, the claims of group 1 and group 3 are

dependent, – that is, they are connected in design, operation and/or effect. (MPEP § 802.1, 808.01).

Because the Office has not made the requisite showing under the statutory authority and the guidance set forth in the MPEP, the restriction is improper and should be withdrawn.

NO SERIOUS BURDEN TO CONDUCT SEARCH

Restriction under 35 U.S.C. § 121 is never required, as stated by the Office in numbered paragraph 2. Rather it is permissive and improper where an Examiner will not be seriously burdened in searching the invention claimed. Here, the Examiner's search of apparatus claims 1-20 (group 1) will uncover references directed toward the method claims 21 and 22 (groups 2 and 3). For example, the search of group 1 will be co-extensive with that of group 2 for several reasons, not the least of which is their common classification. Indeed, both are directed toward extracting a sample from a strip. Group 3, while classified differently, still contains method steps corresponding to elements in the apparatus claims. Applicant respectfully submits that the Examiner will not be seriously burdened in his search in considering the inventions described in the restricted claims. Therefore, to conserve time and expense for both the Office and the Applicant, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement.

CONCLUSION

For the reasons above, the restriction requirement is improper and should be withdrawn.

Applicant appreciates the Examiner's attention to this matter. Please charge any additional fees or credit any overpayments to Deposit Account 02-2051 referencing Attorney Docket No. 24221-88-2.

Respectfully submitted,



W. Scott Harders
Reg. No. 42,629

BENESCH, FRIEDLANDER
COPLAN & ARONOFF LLP
2300 BP Tower
200 Public Square
Cleveland, OH 44114-2378
(216) 363-4443